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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,822	01/05/2004	Kazuto Ikemoto	396.43366X00	1645

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,822

Applicant(s)

IKEMOTO, KAZUTO

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3-10, 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims rejected are 1-2, 11-13 and 16-21 with respect to the elected and applied species for making the "reaction product".

This is in response to Paper filed on 02 December 2006.

- I. There is on the record that applicant elects ethanolamine, isopropanolamine, dimethyl sulfoxide, citric acid species being acknowledged.
- II. The elected species are now considered and searched with respect to the species for making the "reaction product" in a new search only. The consideration and search are extended to the applied species. Other have not been considered, searched or examined until all of the elected and applied species are overcome.
- III. There is on the record that applicant elect the invention of Group I, claims 1-2, 11-13 and (16-21 as later added) on 02 May 2005.
- IV. A correction to "Chemical review, vol.26..." is noted.
- V. Soviet Patent No. "1534029" is disclosed to be essential and pertinent to the instant claims as originally filed but now is deleted. Why is it deleted? The claim would have no value if someone later show that there is at least a pertinent embodiment in the patent.

VI. Upon further reviewing of the arguments to the restriction on the record mailed on 01 April 2005, the arguments are not found to be convincing.

Accordingly, the restriction is maintained for the reasons set forth below.

Applicant's election with traverse of the invention of Group I, Claims 1-2, 11-13 and (16-21 as later added) on 02 May 2005 in the reply filed on 02 May 2005 is acknowledged. The traversal is on the ground(s) that all claim are related to agent (reacted compound) alone, the agent is for photoresist stripping process and additional search is not burden. This is not found persuasive because the non-elected invention of Group II, claims 3-10 are related compositions, the reacted compound is used as a textile clean agent as disclosed, taught, suggested and reduce to practice in Nosler et al (3,625,644). There is a requirement of a new search in each Office action in response to applicant's arguments. Accordingly, new search is made in the Office action. Additional search is burdensome.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, the Office action mailed on 02 June 2005 is with drawn.

VII. For the language "reaction product...0.8" being and considering as a product-by-process, the law sets forth that a patentability of a claimed being related

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to a product-by-process is restrictedly on the product, per se, unless applicant show or provide a convincing evidence that the claimed process embodiment of making the reacted product is patentably distinct product from a known product for a patentability of the claimed product-by-process in accordance with the authority stated in at least *In re Fessmann*, 180 USPQ 324.

VIII. For a functional property of a material instead of an precisely defined chemical compound by a precisely chemical elements with the precisely bond connections among the elements. (The law sets forth that describing or claiming a function of a material (chemical compound) instead of a precisely chemical compound in a claim for consideration and search carries with a risk in accordance with the authority stated in *In re Swinehart*, 169 USPQ 226. For a proper response to an Office action being related to the function, applicant is required to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429 since an argument alone is not a evidence.

IX. For a citation of a property of a known material (reacted product) in a material claim, the law sets forth that the property is and considered as inherent and the patentability of the claimed material is restrictedly on the claim material,

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per se, in accordance with the authority stated in at least *In re Thuau*, 57 USPQ 324; *In re Pearson*, 181 USPQ 641. However, it is given full value in a process claim.

VIII. Claims 1-2, 11-13 and 16-21 are provisionally rejected under 35 U.S.C. 102 (b) as being anticipated by Chemical Review, Vol. 26 as corrected by applicant until a pertinent portion or copy is submitted. A pertinent portion or copy is requested for the record before or at the same time of an appeal brief is found otherwise, the appeal brief is not considered and is dismissed.

There is on the record that applicant discloses and teaches in the instant application that the author in the Chemical Review discloses and teaches a reacted compound using formaldehyde and alkanolamine reactants as that in the instant claims.

The intended use with respect to “photoresist stripping” in the preamble of the claims has no value in the above applied statutory.

For the embodiments being related to product-by-process, function of a material and property of a known material in the claims, please see the reasons set for below:

For the language “reaction product...0.8” being and considering as a product-by-process, the law sets forth that a patentability of a claimed being related to a product-by-process is restrictedly on the product, per se, unless applicant show or provide a convincing evidence that the claimed process embodiment of making the reacted product is patentably distinct product from a known product for a patentability of the claimed product-by-process in accordance with the authority stated in at least *In re Fessmann*, 180 USPQ 324.

For a functional property of a material instead of an precisely defined chemical compound by a precisely chemical elements with the precisely bond connections among the elements. (The law sets forth that describing or claiming a function of a material (chemical compound) instead of a precisely chemical compound in a claim for consideration and search carries with a risk in accordance with the authority stated in *In re Swinehart*, 169 USPQ 226) For a proper response to an Office action being related to the function, applicant is required to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429 since an argument alone is not a evidence.

For a citation of a property of a known material (reacted product) in a material claim, the law sets forth that the property is and considered as inherent and the patentability of the claimed material is restrictedly on the claim material,

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per se, in accordance with the authority stated in at least *In re Thuau*, 57 USPQ 324; *In re Pearson*, 181 USPQ 641. However, it is given full value in a process claim.

Accordingly, the claims are reasonably considered as provisionally anticipated by Chemical Review as admitted by applicant on the record.

VIII. Claims 1-2, 11-13 and 16-21 are provisionally rejected under 35 U.S.C. 102 (b) as being anticipated by Soviet Patent No. 1534029 as admitted applicant as originally filed application until a pertinent portion in English language is submitted. A pertinent portion in English language is requested for the record before or at the same time of an appeal brief is found otherwise, the appeal brief is not considered and is dismissed.

There is on the record that applicant discloses and teaches in the instant application that patentee in the patent discloses and teaches a reacted compound using formaldehyde and alkanolamine reactants as that in the instant claims.

For the embodiments being related to product-by-process, function of a material and property of a known material in the claims, please see the reasons set for below:

The intended use with respect to “photoresist stripping” in the preamble of the claims has no value in the above applied statutory.

For the language “reaction product...0.8” being and considering as a product-by-process, the law sets forth that a patentability of a claimed being related to a product-by-process is restrictedly on the product, per se, unless applicant show or provide a convincing evidence that the claimed process embodiment of making the reacted product is patentably distinct product from a known product for a patentability of the claimed product-by-process in accordance with the authority stated in at least *In re Fessmann*, 180 USPQ 324.

For a functional property of a material instead of an precisely defined chemical compound by a precisely chemical elements with the precisely bond connections among the elements. (The law sets forth that describing or claiming a function of a material (chemical compound) instead of a precisely chemical compound in a claim for consideration and search carries with a risk in accordance with the authority stated in *In re Swinehart*, 169 USPQ 226. For a proper response to an Office action being related to the function, applicant is required to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429 since an argument alone is not a evidence.

For a citation of a property of a known material (reacted product) in a material claim, the law sets forth that the property is and considered as inherent and the patentability of the claimed material is restrictedly on the claim material, per se, in accordance with the authority stated in at least *In re Thuau*, 57 USPQ 324; *In re Pearson*, 181 USPQ 641. However, it is given full value in a process claim.

Accordingly, the claims are reasonably considered as provisionally anticipated by Soviet Patent as admitted by applicant on the record.

IX. Claims 1-2, 11-13 and 16-21 are rejected under 35 U.S.C. 102 (b) as being anticipate by Nosler et al (3,625,644 as being equivalent to JP 46-26903) as admitted applicant in the application as originally filed.

There is on the record that applicants discloses and teach in the instant application that patentees in the patent discloses and teaches a reacted compound using formaldehyde and alkanolamine reactants as that in the instant claims.

There is on the record that applicant discloses and teach in the instant application that the author in the Chemical Review discloses and teaches a reacted compound using formaldehyde and alkanolamine reactants as that in the instant claims.

The intended use with respect to “photoresist stripping” in the preamble of the claims has no value in the above applied statutory.

For the embodiments being related to product-by-process, function of a material and property of a known material in the claims, please see the reasons set for below:

For the language “reaction product...0.8” being and considering as a product-by-process, the law sets forth that a patentability of a claimed being related to a product-by-process is restrictedly on the product, per se, unless applicant show or provide a convincing evidence that the claimed process embodiment of making the reacted product is patentably distinct product from a known product for a patentability of the claimed product-by-process in accordance with the authority stated in at least In re Fessmann, 180 USPQ 324.

For a functional property of a material instead of an precisely defined chemical compound by a precisely chemical elements with the precisely bond connections among the elements. (The law sets forth that describing or claiming a function of a material (chemical compound) instead of a precisely chemical compound in a claim for consideration and search carries with a risk in accordance with the authority stated in In re Swinehart, 169 USPQ 226For a proper response to an Office action being related to the function, applicant is required to show or

provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429 since an argument alone is not a evidence.

For a citation of a property of a known material (reacted product) in a material claim, the law sets forth that the property is and considered as inherent and the patentability of the claimed material is restrictedly on the claim material, per se, in accordance with the authority stated in at least *In re Thuau*, 57 USPQ 324; *In re Pearson*, 181 USPQ 641. However, it is given full value in a process claim.

Accordingly, the claims are reasonably considered as anticipated by *Nosler et al* as admitted by applicant on the record.

X. Claims 1-2, 11-13 and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by *Gatlin* (5,486,605).

Gatlin discloses and teaches a reaction product of an formaldehyde and hindered amine being selected from an alkanolamine. Please see col.3:49-51, 4:7-8, 39-44 and 52-61, 5:7 and 9-11.

The intended use with respect to “photoresist stripping” in the preamble of the claims has no value in the above applied statutory.

For the embodiments being related to product-by-process, function of a material and property of a known material in the claims, please see the reasons set for below:

For the language “reaction product...0.8” being and considering as a product-by-process, the law sets forth that a patentability of a claimed being related to a product-by-process is restrictedly on the product, per se, unless applicant show or provide a convincing evidence that the claimed process embodiment of making the reacted product is patentably distinct product from a known product for a patentability of the claimed product-by-process in accordance with the authority stated in at least *In re Fessmann*, 180 USPQ 324.

For a functional property of a material instead of an precisely defined chemical compound by a precisely chemical elements with the precisely bond connections among the elements. (The law sets forth that describing or claiming a function of a material (chemical compound) instead of a precisely chemical compound in a claim for consideration and search carries with a risk in accordance with the authority stated in *In re Swinehart*, 169 USPQ 226. For a proper response to an Office action being related to the function, applicant is required to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429 since an argument alone is not a evidence.

For a citation of a property of a known material (reacted product) in a material claim, the law sets forth that the property is and considered as inherent and the patentability of the claimed material is restrictedly on the claim material, per se, in accordance with the authority stated in at least In re Thuau, 57 USPQ 324; In re Pearson, 181 USPQ 641. However, it is given full value in a process claim.

Accordingly, the claims are reasonably considered as anticipated by Gatlin.

Applicant's arguments filed 02 December 2005 have been fully considered but they are not persuasive.

(1) The intended use with respect to “photoresist stripping” in the preamble of the claims has no value in the above applied statutory.

(2) For the language “reaction product...0.8” being and considering as a product-by-process, the law sets forth that a patentability of a claimed being related to a product-by-process is restrictedly on the product, per se, unless applicant show or provide a convincing evidence that the claimed process embodiment of making the reacted product is patentably distinct product from a known product for a patentability of the claimed product-by-process in accordance with the authority stated in at least In re Fessmann, 180 USPQ 324.

XI. Claims 1-2, 11-13 and 16-21 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dillon (4,978,512).

Dillon discloses and teaches a reaction product of an formaldehyde and an alkanolamine from 1-6 carbon atoms in a molar ratio of from 0.25:1. Please see col.4:16-24 and 42-45.

The intended use with respect to “photoresist stripping” in the preamble of the claims has no value in the above applied statutory.

For the embodiments being related to product-by-process, function of a material and property of a known material in the claims, please see the reasons set for below:

For the language “reaction product...0.8” being and considering as a product-by-process, the law sets forth that a patentability of a claimed being related to a product-by-process is restrictedly on the product, per se, unless applicant show or provide a convincing evidence that the claimed process embodiment of making the reacted product is patentably distinct product from a known product for a patentability of the claimed product-by-process in accordance with the authority stated in at least In re Fessmann, 180 USPQ 324.

For a functional property of a material instead of an precisely defined chemical compound by a precisely chemical elements with the precisely bond connections among the elements. (The law sets forth that describing or claiming a function of a material (chemical compound) instead of a precisely chemical compound in a claim for consideration and search carries with a risk in accordance with the authority stated in *In re Swinehart*, 169 USPQ 226. For a proper response to an Office action being related to the function, applicant is required to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429 since an argument alone is not a evidence.

For a citation of a property of a known material (reacted product) in a material claim, the law sets forth that the property is and considered as inherent and the patentability of the claimed material is restrictedly on the claim material, per se, in accordance with the authority stated in at least *In re Thuau*, 57 USPQ 324; *In re Pearson*, 181 USPQ 641. However, it is given full value in a process claim.

Accordingly, the claims are reasonably considered as anticipated by Dillon.

Applicant's arguments filed 02 December 2005 have been fully considered but they are not persuasive.

(1) For the language “reaction product...0.8” being and considering as a product-by-process, the law sets forth that a patentability of a claimed being related to a product-by-process is restrictedly on the product, per se, unless applicant show or provide a convincing evidence that the claimed process embodiment of making the reacted product is patentably distinct product from a known product for a patentability of the claimed product-by-process in accordance with the authority stated in at least In re Fessmann, 180 USPQ 324.

(2) The intended use with respect to “photoresist stripping” in the preamble of the claims has no value in the above applied statutory. Applicant traverses being acknowledged. But it is believed that the action as taken is correct by law.

XII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Cynthia Kelly can be reached on 571-272-1526.

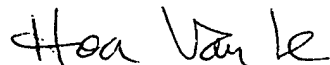
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Applicants may file a paper by fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
18 January 2006

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.